BRIEF FOR PETITIONERS IN SUPPORT OF APPLICATION FOR WRIT OF CERTIORARI

This is an application for a writ of certiorari to be directed to the United States Circuit Court of Appeals for the First Circuit to review the decree herein, the particulars of which are set forth in the foregoing petition.

Opinions Below

The opinion delivered by the District Court is reported in 48 F. Supp. 187, that of the Circuit Court of Appeals in 131 F. (2d) 398.

Statement of the Case

The essential facts of the case are fully stated in the accompanying petition for certiorari and in the interest of brevity are not repeated here. Any necessary reference thereto or elaboration thereof will be made in the course of the argument which follows.

Specification of Errors

The Circuit Court of Appeals for the First Circuit erred, it is respectfully submitted:

1. In holding that Gruber did not assign to Egner and Mayer in 1921 all his right, title and interest in the song.
2. In holding that Egner and Mayer were licensees, but not assigns.
3. In holding that Egner and Mayer were not proprietors of the song.
4. In holding that Egner and Mayer could not copyright the song when they copyrighted their compilation.

5. In holding that when the compilation of Egner and Mayer was put on sale at the West Point Hotel, this publication and sale with the consent of Gruber amounted to such a general publication as to dedicate the song to the public.

6. In failing to hold that there had been no abandonment of the right to obtain copyright.

7. In failing to hold that plaintiffs were not barred by *laches*.

8. In affirming the judgment of the District Court.

ARGUMENT

I

The evidence established an assignment by Gruber to Egner and Mayer.

The scope of the review: Under the amendment by this Court in 1939 of Rule 1 of the Rules of Practice in Copyright cases, proceedings in such actions are now governed by the Rules of Civil Procedure, in so far as not inconsistent with the Rules in copyright cases.

> Civil Procedure Rule 52, subd. (a) third sentence provides: "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."
>
> The last sentence of subdivision (b) provides "When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question has made in the district court an objection to such findings or has made a motion to amend them or for judgment."

The third sentence of subdivision (a), according to the notes of the Advisory Committee, "accords with the decisions on the scope of review in modern federal equity practice". That scope was defined by Chief Justice Taft, in *Keller* v. *Potomac Electric Power Co.*, 261 U. S. 428, 444; 43 S. Ct. 445, as follows:

> "In that procedure an appeal brings up the whole record and the appellate court is authorized to review the evidence and make such order or decree as the court of first instance ought to have made, giving proper weight to the findings on disputed issues of fact which should be accorded to a tribunal which heard the witnesses."

The testimony as to the assignment comes from Mayer. Gruber died shortly after this action was brought (R. 141, 164). Mayer testified that he had written Gruber and conversed with him (R. 33, 36). The correspondence was destroyed within a few months after publication of the book (R. 35). The proof thus rested on Mayer's testimony. He testified (R. 33) that he had written Gruber for the rights, and Gruber responded either by letter or orally; he was uncertain which. However, that is not crucial, for it was competent for Gruber before copyright to transfer by parol whatever right he had to convey.

Callaghan v. *Myers*, 128 U. S. 617, 658, 9 S. Ct. 177.

While he did, to some extent, state his conclusion that Gruber gave him and Egner the right to print and copyright (R. 33, 34, 36, 38), he nevertheless testified as a fact (R. 39) that Gruber gave them the song and the right to copyright it; that Gruber stated (R. 34) this was the first time it had ever been published in the public domain with his consent and he emphasized the need of protecting it with a copyright; and (R. 42) that he had Gruber's complete word before the date of publication.

True, Mayer is a nominal plaintiff. But the only plaintiff in interest is Shapiro, Bernstein & Co., Inc. Egner and

Mayer were joined solely for procedural purposes. They had assigned to Gruber (Plffs.' Ex. 8, offered R. 44, printed R. 201). There was reserved to them (Plffs.' Ex. 9, offered R. 44, printed R. 201) the personal non-assignable right to publish the song as part of the "West Point Song Book" (R. 204). Mayer, therefore, had no possible interest in the outcome of this litigation; in any case, his right with Egner to continue to include the song in their book was preserved. His testimony was not contradicted, was not unreasonable or improbable or in its nature surprising or suspicious, and from no reasonable point of view was it open to doubt. Therefore the Trial Court was not at liberty to disregard his testimony (cf. *Chesapeake & O. R. Co.* v. *Martin*, 283 U. S. 209, 216-217, 51 S. Ct. 453).

Furthermore, it was supported by the testimony of Elliott Shapiro that Gruber told him he had parted with his rights to Egner and Mayer (R. 57, 58).

II

There was no dedication or abandonment.

Public rendition of the song prior to copyright was not an abandonment.

Ferris v. *Frohman*, 223 U. S. 424, 435, 32 S. Ct. 263.

Nor would limited publication, as, for example, the distribution of the words only to officers and men in the Army for use solely by song leaders in the Army (R. 10, 127) constitute a dedication to the public (cf. *American Tobacco Co.* v. *Werckmeister*, 207 U. S. 284, 299-300, 28 S. Ct. 72).

There is no evidence that Gruber consented to any of the publications of the song prior to the publication and copyright registration by Egner and Mayer. There is no evidence that he knew of any such publication. Sousa's might appear to be an exception (R. 167) but Danford had never seen the song in print prior to the Egner-Mayer publica-

tion (R. 148, 162); so Danford, speaking of Gruber's knowledge (R. 167), must have referred to some later time; and this has confirmation in his further testimony (R. 167) that he never heard Gruber refer to the publication of the song by others during the years immediately preceding 1921.

It is submitted, therefore, that a finding of abandonment or dedication prior to the Egner and Mayer copyright is without support in the evidence.

After the assignment by Gruber and the publication and registration by Egner and Mayer, Gruber had no right or power to authorize publication.

Goldmark v. *Kreling*, 35 Fed. 661-662.

And it would necessarily follow that his conduct after he had divested himself of ownership should not constitute the basis for a claim of abandonment.

The Circuit Court held (R. 268) that when the Egner-Mayer compilation was put on sale at the West Point Hotel this publication and sale with the consent of Gruber amounted to such a general publication as to dedicate the song to the public and worked an abandonment of Gruber's common-law right to a copyright.

It may be conceded that, when a work is copyrighted or is published generally without copyright, there is an end of the so-called common-law copyright; but it is submitted that when publication is made by the authority of the proprietor with proper copyright notice that does not constitute a dedication of the work to the public, but rather a substitution of the statutory for the common-law copyright.

Bobbs-Merrill Co. v. *Straus*, 147 Fed. 15, 19, 77 C. C. A. 607, aff'd 210 U. S. 339, 28 S. Ct. 722.

III

Plaintiffs are not barred by *laches*.

The Trial Court based its finding of *laches* exclusively on the factor of delay (R. 20). It is submitted that mere delay is insufficient to bar plaintiffs; it must appear that the delay has worked to the disadvantage of the defendant. If the conduct of defendant has not been induced or varied by anything done or omitted by plaintiffs or Gruber, there are no *laches*.

Gilmore v. *Anderson*, 38 Fed. 846, 848.

While *laches*, in the sense of mere delay in bringing suit may defeat a preliminary injunction, it will not, on final hearing, prevent the Court from granting relief against continuance of the infringement.

Cf. *Sawyer Spindle Co.* v. *Taylor*, 69 Fed. 837, aff'd 75 Fed. 301, 22 C. C. A. 203 (a patent case).

In a trade-mark case it was held by this Court that

> "Where consent by the owner to the use of his trade-mark by another is to be inferred from his knowledge and silence merely, 'It lasts no longer than the silence from which it springs: it is, in reality, no more than a revocable license'.
>
> "So far as the act complained of is completed, acquiescence may defeat the remedy on the principle applicable when action is taken on the strength of encouragement to do it, but so far as the act is in progress and lies in the future, the right to the intervention of equity is not generally lost by previous delay, in respect of which the elements of an estoppel could rarely arise."

Menendez v. *Holt*, 128 U. S. 514, 524, 9 S. Ct. 143.

It does not appear that defendant's conduct was induced or that it has been prejudiced by any act or omission on the part of plaintiffs or Gruber. Plaintiffs have stipulated, if successful (R. 13-14) to waive damages, accounting for profits, costs and counsel fees, and that defendant may, without royalty payment, dispose of the remainder of their present editions containing The Caisson Song (extended at the trial (F. R. 23) to include two additional editions) giving proper copyright credit; and Mr. Schirmer testified (R. 132) that to the extent that defendant has been permitted to sell these books, it has not been prejudiced by the delay in bringing action.

CONCLUSION

It is respectfully submitted that the petition for a writ of certiorari should be granted.

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